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Serial No. 09/741,207

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

First named inventor: Barber, Timothy P.

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Title: Method for Secure, Closed Loop Money Transfer via
Electronic Mail

Group Art Unit: 3624

Examiner: Felten, Daniel S.

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SUPPLEMENTAL BRIEF FOR APPELLANTS

Sir:

This is a further supplemental brief for the above application, filed in response to an Office action mailed 16 June 2005, and reopening prosecution in response to a supplementary appeal brief filed 21 September 2004. Applicant respectfully hereby maintains the appeal. A Notice of Appeal is included herewith for same.

This brief is filed, and the appeal maintained, following a phone conversation on Aug. 3, 2005, to Robert Bahr, DEPUTY COMMISSIONER FOR PATENT EXAMINATION POLICY, at 571-272-8800, who explained that the option of maintaining the appeal in response to an Office action reopening prosecution is available and is to be exercised by filing a Notice of Appeal and a Supplemental Appeal Brief within the three-month period set for responding to the Office action, with extensions of time available under 37 CFR 1.136(a). This paper and the accompanying Notice of Appeal are believed to be in accord with the procedure explained by Robert Bahr.

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I. THE REAL PARTY IN INTEREST

The real party in interest continues to be Timothy P. Barber, Ph.D., the party named in the caption of the brief.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals and interferences.

III. STATUS OF CLAIMS

Claims 1-8 are pending, and as of the Office action mailed Sept. 21, 2004, continue to stand rejected, and are still being appealed.

IV. STATUS OF AMENDMENTS

No amendments are outstanding.

V. SUMMARY OF THE INVENTION

The invention is a method by which an e-mail recipient is rewarded for reading an e-mail. The intended use of the method is to make it more likely that if a sender sends an advertisement to a recipient by e-mail, the recipient will at least click on the e-mail and so possibly see the advertisement. See page 2, lines 5-9, and also page 3, line 18. According to the method, this is done by offering a reward to the recipient. The reward is money. The reward, or more accurately, the promise of a reward, is conveyed as what in the application and claims is called a *stamp* (Fig. 4), which is included in the e-mail as an attachment. The recipient need only redeem the stamp (step 6, Fig. 1; Fig. 2B) with an entity established for that purpose--typically, but not necessarily, the same entity as issued the stamp--and must do so within a time limit indicated (at least in

part) by a value called the lifespan. See page 3, lines 14-16, and also page 4, lines 18-25. See also page 2, ll. 23-25.

The stamp is set out in the application (introduced at page 5, lines 3-18, and described in detail, in connection with Fig. 4, beginning at page 7, line 16, and continuing to page 9, line 19) and recited in the claims--and in particular claim 1--as being a concatenation of various fields, some of which are (cryptographic) hashes of fields, with the result that the stamp is tamper-proof.

(See page 2, ll. 19-25.) Also, the stamp indicates a value on its face called a face value, which is the amount the recipient would be rewarded if the recipient sends the stamp to the redeeming entity, as well as the above-mentioned time limit. The time limit, recited as a lifespan in the claim, is either a single value, e.g. a date and possibly a time, or two values: a time period and an issue time (a date and time). (See page 2, ll. 23-25 for a teaching of using a single value as the time limit, and see page 7, ll. 23-25, for a teaching of using both a time period value and an issue time value to indicate the time limit.) Thus, the recipient sees the amount of the reward, and how much time is left to claim the reward, but cannot change the amount of reward or the time left since the redeeming entity can detect any tampering based on the hashed fields included as part of the stamp.

It should be understood that the invention is not ever claimed merely as a data object/ stamp, but instead always as a method including--as recited in claim 1--at least the following steps (tracking the data flows 4-6 indicated in Fig. 1 and various of the steps shown in Figs. 2A and 2B):

a) a stamp issuer providing to a sender a stamp (Fig. 1, step 4) having a face value and a lifespan both indicated on the stamp (page 6, line 5), the stamp being a string that is a concatenation of two or more fields including the face value

(page 7, line 26) and the lifespan (page 7, line 23), with at least one of the fields calculated according to a prescription involving a hashing or encryption of a concatenation of others of the fields or of some other field not part of the stamp (page 8, line 4);

b) the sender affixing the stamp to an e-mail and sending the e-mail to a recipient (Fig. 1, step 5; and page 6, line 26); and

c) the recipient of the e-mail redeeming the stamp (Fig. 1, step 6) for the face value by presenting the stamp to a predetermined entity (page 11, lines 3-8 and line 26).

Claims 2-7 are directed to different embodiments of the invention in respect to a stamp according to the invention (Fig. 4). Claim 8 is used to make clear that the entity that redeems such a stamp may or may not be the same as the stamp issuer.

VI. ISSUE

The following issue will be addressed in the argument: whether the Office action mailed June 16, 2005 (hereinafter the Office action) erred in rejecting claims 1-8 under 35 USC section 103 as being unpatentable over Kuzma (U.S. Pat. No. 5,771,289) in view of Messner (U.S. Pat. No. 6,370,514).

VII. GROUPING OF THE CLAIMS

With respect to the rejection of under 35 USC section 103, all claims are involved, namely claims 1-8, and (only) the rejection of claim 1 is argued, and claims 2-8 are to stand or fall with claim 1.

VIII. ARGUMENT

A. ERROR IN REJECTION OF CLAIM 1 UNDER 35 USC SECTION 103

At section 3 of the Office action, claim 1 is rejected under 35 USC §103(a) as being unpatentable over Kuzma (U.S. Pat. No. 5,771,289) in view of Messner (U.S. Pat. No. 6,370,514).

In the rejection, the Office action asserts that Kuzma discloses a method of providing for a money transfer over a network, citing col. 1, ll. 15-35, repeated here:

Electronic data transmission is known. For example, it is known that remote devices, such as computers and telefax machines can transmit and receive data over telecommunications networks. Such networks can be standard telephone lines, satellite transmission paths, digital microwave radio links, optical fibers or digital data transmission lines. They include local or wide area configurations. The communication channels can be provided by the owners of the network but more typically are leased from a common carrier, i.e. the telephone company. A modern network may consist of thousands of computing devices made by various manufacturers connected by a variety of transmission media spanning international and intercontinental boundaries.

Data transmission often is in the form of what is known as electronic mail. Electronic mail may be transmitted by means of point-to-point systems or computer based message systems.

Point-to-point systems link two specific terminals together for the duration of the transmission, and include telegrams, mailgrams, TELEX, TWX, and telefax.

Applicant respectfully submits that there is simply no teaching or suggesting at col. 1, ll. 15-35 in Kuzma of providing for a money transfer over a network, but instead only the mention of the existence of some different forms of electronic data transmission over a network, including "*computer based message systems*," described at col. 1, ll. 36-44, as the form of electronic data transmission we typically call "e-mail." And

Kuzma nowhere else discloses a method of providing for a money transfer over a network. Instead, Kuzma discloses a method (and corresponding equipment) by which payment is required in order to transmit an electronic message, payment that is made as the message is transmitted, using a previously obtained electronic stamp or credit. Thus, Kuzma discloses an e-mail analog of the usual postage stamp used in what today is called "snail mail," i.e. ordinary mail conveyed by a Post Office organization.

Requiring a stamp for an electronic mail piece is one attack on stopping either spam and/ or junk electronic mail; it forces a sender to pay for each electronic mail piece. Claim 1, by contrast, adopts another strategy, less onerous in case of senders of electronic messages that would not be considered spam/ junk electronic mail. In the method recited in claim 1, a person sending an electronic message (typically for advertising) entices the addressee to open and read the message by indicating to the addressee that by so doing, the addressee can receive a reward. All that the addressee need do is to redeem a "stamp" included with the electronic message (claim 1 reciting a step in which the recipient of the e-mail redeems the stamp for the face value by presenting the stamp to a predetermined entity). Thus, with the invention, a sender of advertising would be less inclined to send an electronic message to too many addresses, since each addressee could redeem the stamp included with the message. At the same time, a sender of personal or non-advertising messages need not worry about having to pay for sending an electronic message.

In relying on Kuzma as a primary reference, it seems to applicant's representative that perhaps the Office is focusing too much on the use of the word "stamp" in the invention as in the claims. The term "reward indicia" might be a more suitable label, and would make more clear that the "stamp" of the invention as in the claims, i.e. a reward indicia, is not at all the same kind of thing as the "stamp" of Kuzma, which is intended

to be an actual e-mail analog of an ordinary postage stamp (i.e. a stamp as used in "snail mail"). However, as it is commonly accepted that an applicant can be a lexicographer and provide in the applicant's application the meaning for a term that is different from the ordinary meaning, applicant respectfully submits that the use of the term "stamp" in claim 1 is not to be confused with a postage stamp. a postage stamp is proof of the payment required for delivery of the correspondence to which it is attached, whereas the "stamp/ reward indicia" of claim 1 is, according to the application and as implicitly defined by claim 1, an indication (on its face) of a reward (face value) available to the recipient if the recipient opens the email to which it is attached, and redeems the stamp/ reward within the lifespan indicated on the stamp/ reward.

After asserting that Kuzma discloses a method of providing for a money transfer over a network, the Office action next asserts that at col. 2, line 66 to col. 3, line 16, Kuzma discloses a step of "providing a stamp having a face value indicated on the stamp." The cited text is:

... The electronic stamp preferably is a data packet that when processed by the carrier or at the addressee location appears as a stamp-like graphic marking on the transmitted document. Substantially concurrently with application of the electronic stamp to the electronic data, the counter or database containing the data corresponding to the sender's amount of electronic stamps is debited in an amount equal to the value of the affixed electronic stamp to reflect the use of the electronic stamp to pay for the electronic transmission of the data or message.

Also preferably substantially concurrently with the transmission of the data, the electronic stamp or stamp is "canceled" to prevent its further, fraudulent use. The cancellation mark preferably shows that the carrier has received the letter and that the electronic stamp has been accepted for transmission of the data. The cancellation mark also can identify the date and time the data was sent.

Applicant concedes that since the stamp disclosed in Kuzma is a "stamp-like graphic," it likely would indicate a value, but the value would not be the "face value" recited in claim 1 since it is not a value for which the stamp can be redeemed, as recited in claim 1, so that claim 1 implicitly defines "face value" as a value for which a stamp can be redeemed, not the amount paid for a stamp. In other words, unlike the face value of claim 1, the value of a Kuzma stamp is not a value as far as the recipient of the stamp is concerned, but rather a cost paid by the sender to send the electronic message.

Next in rejecting claim 1, the Office action asserts that in Figs. 4a-d, and at col. 5, ll. 47+, and col. 6, ll. 37-40, Kuzma discloses "a stamp being a string that is a concatenation of two or more fields including the face value." Applicant respectfully submits that none of Figs. 4a-d indicate a face value as in claim 1, let alone a string that is a concatenation (a combining, one after the other, as is understood by anyone skilled in the art of digital equipment) of same. Instead, Kuzma discloses a stamp that is a packet of data "instructing the electronic post office 250 that electronic message 202 should be transmitted," possibly including a unique code for authenticating the stamp, and possibly a graphic indicating cancellation. There is simply no mention of a face value as that term is defined implicitly in claim 1.

For the reasons given, then, applicant respectfully submits that the rejection of claim 1 under 35 USC §103 is error.

But further in respect to the error in rejecting claim 1, the Office action concedes that Messner fails to disclose allowing the recipient of an e-mail to obtain value for a stamp if the stamp is presented to a predetermined entity within the lifespan of the stamp. For such a teaching, the Office action

relies on Messner, citing the abstract and also col. 2, line 61, to col. 4 line 60.

Messner discloses a method for marketing and redeeming vouchers, which are said to include or to be the same as gift certificates or coupons. According to Messner, a purchaser of such a voucher pays for it, and has it sent to a recipient. (Messner provides a centralized voucher server for processing transactions having to do with the purchase and delivery of such vouchers.) There is, however, no teaching or suggestion in Messner of a lifespan associated with such a voucher. Indeed, since a purchaser has paid for the voucher, it would be surprising if there were a lifetime associated with the voucher; there seems to be no motivation for including a time limit on the use of a voucher by the recipient.

Nevertheless, the Office action asserts that: "An artisan would have ... recognized the fact that a 'voucher' may provide a period of time (lifespan) through which the voucher is valid." The Office action thus asserts that Kuzma teaches the invention as in claim 1, but for the stamp having both a value and a lifespan indicated on the stamp, and that Messner teaches a voucher having a value, although not disclosed as a face value but instead typically a value of use only in purchasing a particular product, and that the voucher of Messner could have a lifespan indicated on it, even though such is not disclosed, and so Kuzma in combination with Messner and the assertion that the voucher of Messner could have a lifetime teach the invention as in claim 1. But for the reasons given above, Kuzma cannot fairly be said to teach the invention except for the lifespan limitations, and in addition, Messner certainly does not teach a stamp/ voucher having a lifespan indicated on the stamp/ voucher, irrespective of any question as to the fairness of equating the value of a voucher with a 'face value' as that term is used in

the application. And even if it is fair to say that the voucher of Messner changed to include a lifespan indicated on it is somehow equivalent to the stamp recited in claim 1, what actual motivation would there be for someone to want to include in the method for sending email disclosed by Kuzma the use of a voucher as in Messner but with a lifespan indicated on it? As mentioned above, Kuzma discloses only a method (and corresponding equipment) by which payment is required for transmitting an electronic message, payment that is made as the message is transmitted, using a previously obtained electronic stamp or credit. How would a voucher of use in obtaining a particular product be of use as an e-mail postage stamp in the system disclosed by Kuzma? No ordinary "snail mail" stamp is such a voucher, and further, certainly none has a lifespan indicated on it. So why would one of ordinary skill, seeking to provide an electronic analog of the ordinary postage stamp, be motivated to replace the method disclosed by Kuzma (buy a stamp and attach it to the email, which will not be sent without the stamp) with a voucher as taught by Messner, and further modified to include a lifespan? Applicant respectfully submits that there is no more motivation for modifying the teachings of Kuzma according to the teachings of Messner than there is for modifying our snail mail system according to Messner, i.e. to use vouchers instead of postage stamps.

Therefore, in addition to the grounds argued above (based on Kuzma not teaching a face value), applicant also respectfully submits that the rejection of claim 1 under 35 USC §103 is error because neither Kuzma nor Messner teach or suggest the steps of the method of claim 1 in respect to the use of a stamp (as in claim 1, i.e. a reward indicia) having a face value and a lifespan limiting the time for the stamp to be redeemed for its face value.

C. COROLLARIES OF THE PRECEDING ARGUMENTS

It has been argued above that there was error in rejecting claim 1 under 35 USC §103. Accordingly, and as set out in the above grouping of the claims, it is here asserted that there was error in the rejections under 35 USC §103 of all the other claims remaining in the application, namely claims 2-8, since all of the other claims depend from claim 1, and stand (or fall) with claim 1.

IX. CONCLUSION

For all of the aforementioned reasons, it is respectfully submitted the rejections of all the claims in the application, namely claims 1-8, are error, and the rejections should be reversed. Early allowance of all the claims in the application is earnestly solicited.

Aug. 3, 2005
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X. APPENDIX--THE CLAIMS INVOLVED IN THE APPEAL

1. (Previously presented) A method of providing for a money transfer over a network, comprising steps in which:

a) a stamp issuer provides to a sender a stamp having a face value and a lifespan both indicated on the stamp, the stamp being a string that is a concatenation of two or more fields including the face value and the lifespan, with at least one of the fields calculated according to a prescription involving a hashing or encryption of a concatenation of others of the fields or of some other field not part of the stamp;

b) the sender affixes the stamp to an e-mail and sends the e-mail to a recipient; and

c) the recipient of the e-mail redeems the stamp for the face value by presenting the stamp to a predetermined entity;

wherein the predetermined entity provides the face value to the recipient only if the stamp is presented to the predetermined entity within the lifespan indicated on the stamp.

2. (Original) A method as in claim 1, wherein the stamp is a concatenation of a set of fields, the set comprising:

a) an issue time;

b) a lifespan;

c) a stamp value; and

d) a first-hashed field that is a hash of a concatenation of all of the preceding fields and, in addition a secret constant known only to the stamp issuer.

3. (Original) A method as in claim 2, wherein the first-hashed field is a predetermined truncation of the output of the hash of

the concatenation of all of the preceding fields and, in addition a secret constant known only to the stamp issuer.

4. (Original) A method as in claim 2, wherein the set of fields of which the stamp is a concatenation further comprises a second-hashed field that is a hash of the issue time field, the lifespan field, the stamp value field, and the first-hashed field.

5. (Original) A method as in claim 4, wherein the second-hashed field is a predetermined truncation of the output of the hash of the issue time field, the lifespan field, the stamp value field, and the first-hashed field.

6. (Original) A method as in claim 4, wherein the set of fields of which the stamp is a concatenation further comprises a digital signature field that is a digitally signed encryption of the issue time field, the first-hashed field and the second-hashed field, wherein the encryption is performed using a private key of the stamp issuer.

7. (Original) A method as in claim 4, wherein the set of fields of which the stamp is a concatenation further comprises a digital signature field that is a pre-determined truncation of the issue time field, the first-hashed field, the second-hashed field, and a secret constant, known only to the stamp issuer and other qualified parties.

8. (Previously presented) A method as in claim 1, wherein the predetermined entity is the stamp issuer.